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09/876.290	06/07/2001	Yoshiyuki Yanagisawa	09792909-5046	9540
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ROBERT J. DEPKE LEWIS T. STEADMAN ROCKEY, DEPKE, LYONS AND KITZINGER, LLC SUITE 5450 SEARS TOWER CHICAGO, IL 60606-6306			GRAYBILL, DAVID E	
			ARTUNIT	PAPER NUMBER
			2822	
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Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)			
	09/876,290	YANAGISAWA ET AL.			
Office Action Summary	Examiner	Art Unit			
	David E. Graybill	2822			
The MAILING DATE of this communication app Period for Reply	ears on the cover sheet with the c	orrespondence address			
A SHORTENED STATUTORY PERIOD FOR REPLY WHICHEVER IS LONGER, FROM THE MAILING DATE of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication. If NO period for reply is specified above, the maximum statutory period we failure to reply within the set or extended period for reply will, by statute, Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATION 66(a). In no event, however, may a reply be tim fill apply and will expire SIX (6) MONTHS from the cause the application to become ABANDONE	l. ely filed the mailing date of this communication. O (35 U.S.C. § 133).			
Status					
Responsive to communication(s) filed on <u>13 September 2006</u> . This action is FINAL . 2b) This action is non-final. Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.					
Disposition of Claims					
 4) Claim(s) 1-7 and 11-20 is/are pending in the application. 4a) Of the above claim(s) 3-6,12,13 and 15 is/are withdrawn from consideration. 5) Claim(s) is/are allowed. 6) Claim(s) 1,2,7,11,14 and 16-20 is/are rejected. 7) Claim(s) is/are objected to. 8) Claim(s) are subject to restriction and/or election requirement. 					
Application Papers					
9) ☐ The specification is objected to by the Examiner 10) ☐ The drawing(s) filed on 13 September 2006 is/a Applicant may not request that any objection to the deplacement drawing sheet(s) including the correction 11) ☐ The oath or declaration is objected to by the Examiner 11.	re: a) □ accepted or b) ☑ object Irawing(s) be held in abeyance. See on is required if the drawing(s) is obj	37 CFR 1.85(a). ected to. See 37 CFR 1.121(d).			
Priority under 35 U.S.C. § 119		•			
 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of: 1. Certified copies of the priority documents have been received. 2. Certified copies of the priority documents have been received in Application No. 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received. 					
Attachment(s) 1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date	4) Interview Summary (Paper No(s)/Mail Date 5) Notice of Informal Pa	e			

Application/Control Number: 09/876,290

Art Unit: 2822

Claims 3-6, 12, 13 and 15 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 1-31-6.

Page 2

The following is a quotation of 37 CFR 1.84 Standards for drawings:

- the invention. The views may be plan, elevation, section, or perspective views. Detail views of portions of elements, on a larger scale if necessary, may also be used. All views of the drawing must be grouped together and arranged on the sheet(s) without wasting space, preferably in an upright position, clearly separated from one another, and must not be included in the sheets containing the specifications, claims, or abstract. Views must not be connected by projection lines and must not contain center lines. Waveforms of electrical signals may be connected by dashed lines to show the relative timing of the waveforms.
- (1) Exploded views . Exploded views, with the separated parts embraced by a bracket, to show the relationship or order of assembly of various parts are permissible. When an exploded view is shown in a figure which is on the same sheet as another figure, the exploded view should be placed in brackets. . . .
- (p) Numbers, letters, and reference characters.
- (1) Reference characters (numerals are preferred), sheet numbers, and view numbers must be plain and legible, and must not be used in association with brackets or inverted commas, or enclosed within outlines, e.g., encircled. They must be oriented in the same direction as the view so as to avoid having to rotate the sheet. Reference characters should be arranged to follow the profile of the object depicted.
- (2) The English alphabet must be used for letters, except where another alphabet is customarily used, such as the Greek alphabet to indicate angles, wavelengths, and mathematical formulas.
- (3) Numbers, letters, and reference characters must measure at least.32 cm. (1/8 inch) in height. They should not be placed in the drawing so as to interfere with its comprehension. Therefore, they should not cross or mingle with the lines. They should not be placed upon hatched or shaded surfaces. When necessary, such as indicating a surface or cross section, a reference character may be underlined and a blank space may be left in the hatching or shading where the character occurs so that it appears distinct.
- (4) The same part of an invention appearing in more than one view of the drawing must always be designated by the same reference character, and the same reference character must never be used to designate different parts.

(5) Reference characters not mentioned in the description shall not appear in the drawings. Reference characters mentioned in the description must appear in the drawings.

- (q) Lead lines . Lead lines are those lines between the reference characters and the details referred to. Such lines may be straight or curved and should be as short as possible. They must originate in the immediate proximity of the reference character and extend to the feature indicated. Lead lines must not cross each other. Lead lines are required for each reference character except for those which indicate the surface or cross section on which they are placed. Such a reference character must be underlined to make it clear that a lead line has not been left out by mistake. Lead lines must be executed in the same way as lines in the drawing. See paragraph (I) of this section.
- (r) Arrows . Arrows may be used at the ends of lines, provided that their meaning is clear, as follows:
- (1) On a lead line, a freestanding arrow to indicate the entire section towards which it points;
- (2) On a lead line, an arrow touching a line to indicate the surface shown by the line looking along the direction of the arrow; or
- (3) To show the direction of movement.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(1) because reference character 16 in Fig.3 is used in association with brackets.

The drawings are objected to as failing to comply with 37 CFR 1.84(q) because reference character 16 in Fig.3 does not have required lead lines.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following claimed features must be shown or the features canceled from the claims. No new matter should be entered.

Claim 2, two pairs of opposing side walls formed in a rectangular shape.

Claim 14, two pairs of substantially parallel opposed side walls formed on a solid base member.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Information on current drawing correction practice is available at http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/moreinfoamdt
prac.htm

The objection to the drawings will not be held in abeyance.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The claim 2 terminology "box-shaped member," and "which is positioned on said base member." To further clarify, the specification provides antecedent basis only for subject matter comprising a "box-shaped body" and a "boxed-shaped main body" "comprising" said base member.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 7, 11, 14 and 16-18 are rejected under 35 U.S.C. 101 as being non-statutory because they improperly embrace or overlap two different statutory classes of invention, namely, manufacture and process of using the manufacture, which statutory classes are set forth only in the alternative in 35 U.S.C. 101. In particular, the claims are directed to a manufacture but the following limitations are directed to processes of using the manufacture:

Claim 7, "said height restriction mechanism comprises: a cover member secured over said semiconductor modules";

Claim 11, "said height restriction mechanism being located directly above the stacked semiconductor modules";

Claim 14, "a plurality of semiconductor modules stacked and surrounded by the side walls such that the modules are aligned and their lateral motion is prevented by the side walls," and, "the removable cover member is positioned such that it prevents displacement of an uppermost semiconductor module."

Claim 16, the entire claim.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2, 14 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The undescribed subject matter is the following:

Claim 2, "two pairs of opposing side walls formed in a rectangular shape";

Claim 14, "two pairs of substantially parallel opposed side walls formed on a solid base member."

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The following is a quotation of MPEP 2111.01 [R-3] Plain Meaning:

I. THE WORDS OF A CLAIM MUST BE GIVEN THEIR "PLAIN MEANING" UNLESS THEY ARE DEFINED IN THE SPECIFICATION

While the claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination. During examination, the claims must be interpreted as broadly as their terms reasonably allow. In re American Academy of Science Tech Center, **>367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004)< (The USPTO uses a different standard for construing claims than that used by district courts; during examination the USPTO must give claims their broadest reasonable interpretation.). This means that the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)

(discussed below); Chef America, Inc. v. Lamb-Weston, Inc., 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir. 2004) (Ordinary, simple English words whose meaning is clear and unquestionable, absent any indication that their use in a particular context changes their meaning, are construed to mean exactly what they say. Thus, "heating the resulting batter-coated dough to a temperature in the range of about 400oF to 850oF" required heating the dough, rather than the air inside an oven, to the specified temperature.). One must bear in mind that, especially in nonchemical cases, the words in a claim are generally not limited in their meaning by what is shown or disclosed in the specification. See, e.g., Liebel-Flarsheim Co. v. Medrad Inc., 358 F.3d 898, 906, 69 USPQ2d 1801, 1807 (Fed. Cir. 2004)(discussing recent cases wherein the court expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment). It is only when the specification provides definitions for terms appearing in the claims that the specification can be used in interpreting claim language. In re Vogel, 422 F.2d 438, 441, 164 USPQ 619, 622 (CCPA 1970). See also Superguide Corp. v. DirecTV Enterprises, Inc., 358 F.3d 870, 875, 69 USPQ2d 1865, 1868 (Fed. Cir. 2004) ("Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment."); E-Pass Techs., Inc. v. 3Com Corp., 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) ("Interpretation of descriptive statements in a patent's written description is a difficult task, as an inherent tension exists as to whether a statement is a clear lexicographic definition or a description of a preferred embodiment. The problem is to interpret claims in view of the specification' without unnecessarily importing limitations from the specification into the claims."); Altiris Inc. v. Symantec Corp., 318 F.3d 1363, 1371, 65 USPQ2d 1865, 1869-70 (Fed. Cir. 2003) (Although the specification discussed only a single embodiment, the court held that it was improper to read a specific order of steps into method claims where, as a matter of logic or grammar, the language of the method claims did not impose a specific order on the performance of the method steps, and the specification did not directly or implicitly require a particular order). See also paragraph III., below. There is one exception, and that is when an element is claimed using language falling under the scope of 35 U.S.C. 112, 6th paragraph (often broadly referred to as means or step plus function language). In that case, the specification must be consulted to determine the structure, material, or acts corresponding to the function recited in the claim. In re Donaldson, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994) (see MPEP § 2181- § 2186). In In re Zletz, supra, the examiner and the Board had interpreted claims reading "normally solid polypropylene" and "normally solid polypropylene having a crystalline polypropylene content" as being limited to "normally solid linear high homopolymers of propylene which have a crystalline polypropylene content." The court ruled that limitations, not present in the claims, were improperly imported from the specification. See also In re Marosi, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983) ("Claims are not to be read in a vacuum, and limitations therein are to be interpreted in light of the specification in giving them their broadest reasonable interpretation'." 710 F.2d at 802, 218 USPQ at 292 (quoting In re Okuzawa,

537 F.2d 545, 548, 190 USPQ 464, 466 (CCPA 1976)) (emphasis in original). The court looked to the specification to construe "essentially free of alkali metal" as including unavoidable levels of impurities but no more.). Compare In re Weiss, 989 F.2d 1202, 26 USPQ2d 1885 (Fed. Cir. 1993) (unpublished decision - cannot be cited as precedent) (The claim related to an athletic shoe with cleats that "break away at a preselected level of force" and thus prevent injury to the wearer. The examiner rejected the claims over prior art teaching athletic shoes with cleats not intended to break off and rationalized that the cleats would break away given a high enough force. The court reversed the rejection stating that when interpreting a claim term which is ambiguous, such as "a preselected level of force", we must look to the specification for the meaning ascribed to that term by the inventor." The specification had defined "preselected level of force" as that level of force at which the breaking away will prevent injury to the wearer during athletic exertion. It should be noted that the limitation was part of a means plus function element.)

Claims 2, 7, 11, 14 and 16-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, the scope of the language "box-shaped" is indeterminable because the language is not clearly defined in the disclosure, and it otherwise has no plain meaning. In particular, the scope of the term "box-shaped" cannot be determined because the term box does not define a particular shape.

In claims 16 and 17 the scope of the conditional process limitation, "when the height restriction mechanism is removed and the jig is mounted on the mother substrate, a bottom-most on of the stacked semiconductor modules is caused to come into electrical contact with the mother substrate," is indeterminable because the structure or property of the jig that satisfies the condition is unknown.

Page 9

Art Unit: 2822

In claims 16 and 17 the scope of the conditional process limitation, "when the height restriction mechanism is removed and the jig is mounted on the mother substrate, a bottom-most on of the stacked semiconductor modules is caused to come into electrical contact with the mother substrate," is indeterminable because the structure or property of the jig that satisfies the condition is unknown.

In claim 18 the scope of the conditional process limitation, "when the height restriction mechanism is removed and the jig is mounted on a mother substrate, a bottom-most on of the stacked semiconductor modules is caused to come into electrical contact with the mother substrate," is indeterminable because the structure or property of the jig that satisfies the condition is unknown.

A 8branching path, for which all possible variants for selecting the proper branch to be followed have been specified at the point of branching, is precise and unambiguous and we find that a claim so specified is free of indefiniteness due to "alternativeness." Ex parte Lewin, 154 USPQ 487 (BdPatApp&Int 1967).

The scope of claims 16-18 is indeterminable because the alternative language "when" is the point of branching of a branching path, but all possible variants for selecting the proper branch to be followed have not been specified. Specifically, the possible variant when not is not specified. See also MPEP 2173.05(h)III.

Claims 7, 11, 14 and 16-18 are rejected under 35 U.S.C. 112, second paragraph, because they are directed to both manufacture and a process of using the manufacture. As a result, the scope of the claims cannot be determined. See MPEP 2173.05(p)II. Specifically, the claims are directed to a manufacture but the limitations following limitations are directed to processes of using the manufacture:

Claim 7, "said height restriction mechanism comprises: a cover member secured over said semiconductor modules";

Claim 11, "said height restriction mechanism being located directly above the stacked semiconductor modules";

Claim 14, "a plurality of semiconductor modules stacked and surrounded by the side walls such that the modules are aligned and their lateral motion is prevented by the side walls," and, "the removable cover member is positioned such that it prevents displacement of an uppermost semiconductor module."

Claim 16, the entire claim.

In the rejections infra, generally, reference labels are recited only for the first recitation of identical claim elements.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 19 and 20 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Normington (5397916).

At column ??, Normington discloses a multilayer semiconductor device assembly jig inherently for minimizing the displacement of a plurality of semiconductor modules disposed within the assembly jig during a manufacturing process, comprising: an inherent lateral position restriction mechanism "sides" for positioning and aligning a plurality of stacked semiconductor modules "subassemblies" on a solid base member 81/223 with their respective lateral positions mutually restricted; a removable inherent height restriction mechanism 91/252 inherently for restricting an entire height of said semiconductor modules layered on said base member; a mother substrate inherent alignment mechanism 82/253 inherently for providing alignment with reference to a mother substrate "printed circuit board" on which the jig will be mounted; and further wherein each of the plurality of semiconductor modules is comprised of one or more

Application/Control Number: 09/876,290 Page 12

Art Unit: 2822

semiconductor chips 100 secured to a wiring board 51 that has electrical connections 24 on a top and bottom surface thereof and wherein adjacent semiconductor modules are secured to one another by connections between respective top and bottom surfaces thereof; said lateral position restriction mechanism comprises a box-shaped member formed from two pairs of opposing side walls formed in a rectangular shape and which is positioned on said base member and which has a storage space for storing said semiconductor modules in a layered state, wherein an inner wall surface of said storage space constitutes said lateral position restriction mechanism; said height and lateral position restriction mechanisms inherently function to limit a deformation of the semiconductor modules during the manufacturing process; said mother substrate alignment mechanism is formed in said lateral position restriction mechanism.

Although Normington does not appear to explicitly disclose a printed circuit board, the language, "for minimizing the displacement of a plurality of semiconductor modules disposed within the assembly jig during a manufacturing process" is a statement of intended use of the jig that does not appear to result in a structural difference between the claimed jig and the jig of Normington. Further, because the jig of Normington appears to have the same structure as the claimed jig, it appears to be capable of being

used for the intended use, and the statement of intended use does not patentably distinguish the claimed jig from the jig of Normington. Therefore, because the antecedent basis for the language, "modules" is the intended use language, "for minimizing the displacement of a plurality of semiconductor modules disposed within the assembly jig during a manufacturing process," the language, "modules is comprised of . . . a printed circuit board," is a statement of intended use of the jig that does not appear to result in a structural difference between the claimed jig and the jig of Normington. Further, because the jig of Normington appears to have the same structure as the claimed jig, it appears to be capable of being used for the intended use, and the statement of intended use does not patentably distinguish the claimed jig from the jig of Normington. The manner in which a product operates is not germane to the issue of patentability of the product; Ex parte Wikdahl 10 USPQ 2d 1546, 1548 (BPAI 1989); Ex parte McCullough 7 USPQ 2d 1889, 1891 (BPAI 1988); In re Finsterwalder 168 USPQ 530 (CCPA 1971); In re Casey 152 USPQ 235, 238 (CCPA 1967). Also, "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim."; Ex parte Thibault, 164 USPQ 666, 667 (Bd. App. 1969). And, "Inclusion of material or article worked upon by a structure being

claimed does not impart patentability to the claims."; In re Young, 25 USPQ 69 (CCPA 1935) (as restated in In re Otto, 136 USPQ 458, 459 (CCPA 1963)). And, claims directed to product must be distinguished from the prior art in terms of structure rather than function. In re Danley, 120 USPQ 528, 531 (CCPA 1959). "Apparatus claims cover what a device is, not what a device does [or is intended to do]." Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

Applicant's amendment and remarks filed 9-13-6 have been fully considered and are treated supra and infra.

Applicant states, "Regarding claim 14, any one of Figures 2(d), 2(e), 3, 4, 5(a), 5(b), and 6 show the box shaped jig comprised of the vertical walls of the body 15 or the height restriction members 33. More specifically, Figure 5(b) clearly shows two pair of parallel opposed side wails 33. Figures 2(d), 2(e), 3, 4, while being limited to a cross-section view of the box shaped member, when read in light of the specification, clearly teaches that the semiconductor modules 2 are surrounded on all sides by the walls of the body 15 in these embodiments. This necessarily requires the box-shaped member be comprised of two pair of parallel opposed side walls of the body 15," and, "in regard to claim 2, Applicants respectfully direct the Examiner's attention to figure 6 and the supporting portion of the specification, which

clearly shows a box shaped member and including walls 33 positioned on the base member and 31."

These assertions are respectfully deemed unpersuasive and traversed because there is no objection to the box shaped jig comprised of the vertical walls of the body 15 or the height restriction members 33. Furthermore, Figure 5(a), 5(b), and 6 are not drawn to the elected species of Figure 4. Also, applicant merely cites the "specification" without elucidation, and the citations do not otherwise appear to support the assertions.

The art made of record and not applied to the rejection is considered pertinent to applicant's disclosure. It is cited primarily to show inventions relevant to the examination of the instant invention.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

For information on the status of this application applicant should check PAIR: Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alternatively, applicant may contact the File Information Unit at (703) 308-2733. Telephone status inquiries should not be directed to the examiner. See MPEP 1730VIC, MPEP 203.08 and MPEP 102.

Any other telephone inquiry concerning this communication or earlier communications from the examiner should be directed to David E. Graybill at (571) 272-1930. Regular office hours: Monday through Friday, 8:30 a.m. to 6:00 p.m.

The fax phone number for group 2800 is (571) 273-8300.

David E. Graybill Primary Examiner Art Unit 2822

D.G. 22-Nov-06